

III. Remarks

Claims 1-4 and 6 are presented for continued examination. Claims 1, 2 and 5 have been amended. Neither amendment is limiting. The amendment to Claim 2 was inherent in the disclosure. It was obvious that the disclosure indicated that when R3 was H, R1 is equal to H and OH. The amendment to Claim 6 was to correct dependency from a canceled Claim. No estoppel should result. The amendment to Claim was to add that the mammal being administered the compound is suffering from atherosclerosis.

A. Rejections under 35 USC §112

Applicants have addressed and corrected the Claims to remove the §112 rejections. Applicants respectfully request reconsideration of the rejections.

B. Rejections under 35 USC102 §102

Applicants have added the limitation that the mammal being administered the compound is suffering from atherosclerosis. The reference neither teaches nor discloses that the postmenopausal women are suffering from atherosclerosis. Accordingly, the reference does not teach all of the limitations of the Claims. Applicants respectfully request reconsideration, in light of this response.

C. Rejection Under 35 USC §103

The Examiner maintains his assertion that the subject application is obvious over Haenggi *et al.* in view of Berglund. Specifically the Examiner argues that Haenggi *et al.* teach that tibolone decreases lipoprotein-A [Lp(A)] levels and that Lp(A) has been shown to be a strong risk factor for coronary heart disease. Further, the Examiner contends that this teaching, when taken in combination with Berglund, that the Examiner contends teaches that Lp(A) has been implicated with an increased risk of atherosclerosis renders the subject application obvious.

Applicants respectfully request reconsideration in light of this response and the amendment made to Claim 1. Applicants contend that the teachings of the prior art are being misconstrued and should be understood differently. Further, there can be no question that the references do not teach that the post menopausal women are suffering from atherosclerosis.

In the description of the subject application, starting on line 29 of page 2 to line 24 of page 3, it is explained that Tibolone has been the subject of studies assessing its long-term effects on lipid metabolism, since the compound (in addition to estrogenic activity) also has progestogenic activity and androgenic properties. These latter properties are associated with negative effects on lipoproteins, that is, causing 'a significant decrease in

HDL-cholesterol and its major apolipoprotein A-1' (first paragraph of the

Discussion on p.648 of Haenggi *et al.*). The studies indicated that the possibly beneficial decreasing effect of Tibolone on lipoprotein A serum levels 'might counterbalance, at least to some extent, the theoretical adverse effect on the other lipoprotein risk factors.' *i.e.*, those related to coronary heart disease (last paragraph of the Summary on page 645 of Haenggi *et al.*). Thus it can be concluded that Haenggi *et al.* merely teaches that with the administration of Tibolone, there is a possible balancing of positive and negative effects on coronary heart disease risk factors. Haenggi *et al.* does not teach or suggest the unexpectedly strong atheroprotective properties of Tibolone, that renders it useful in a method for inhibiting atherosclerosis.

According to Berglund, 'Lp (A) has been implicated with an increased risk of atherosclerosis and cardiovascular disease. Again, from this, the person skilled in the art can only conclude that with the administration of Tibolone, there is a possible balancing of positive and negative effects on atherosclerosis and cardiovascular disease risk factors. Berglund does not teach or suggest the unexpectedly strong atheroprotective properties of Tibolone which render it useful in a method for inhibiting atherosclerosis.

Applicants maintain that the properties of Tibolone, that underpins its utility in a method for inhibiting atherosclerosis, are not dealt with by either of the two cited prior art documents. Further, the subject application presents

experimental data in support of this. As is explained in the specification of the present application (page 5, line 14 to page 6, line 8), Tibolone has an unexpected, significant and beneficial atheroprotective effect which is completely independent from its previously disclosed effects on plasma lipoproteins or lipoprotein A. The present inventors found that the compounds of formula I have a direct effect on cholesterol accumulation in the vessel wall. These effects on the vessel wall were observed in a generally accepted, relevant and validated atherosclerosis rabbit model. It is to be noted that in this rabbit model, lipoprotein A does not play a role at all, since it is not present in rabbit plasma. The unexpected and surprising effects of the present invention can be seen, for example, by comparing the data in Table III for Tibolone (i.e., Org OD 14) and estradiol (decanoate). Tibolone completely prevented cholesterol accumulation (i.e., expressed as cholesterol level) in the aortic arch whereas estradiol (decanoate) did not lead to a reduction in cholesterol accumulation. Furthermore, fatty streak formation in the aortic arch was completely prevented by treatment with Tibolone, whereas estradiol decanoate had only minor effects.

These unexpectedly strong atheroprotective effects of Tibolone could not have been derived from any of the prior art knowledge or teachings either alone or when taken together. Applicants therefore maintain that the claims

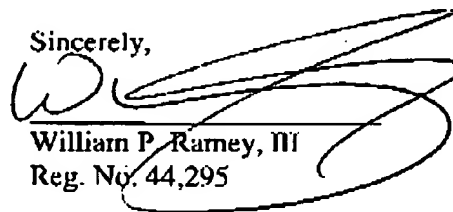
of the present invention are not rendered obvious by the cited art. As was

discussed in *Interconnect Planning Corp. v. Feil*, 774 F.2d 1132, 1143, 227 USPOQ 543, 551 (Fed. Cir. 1985), it is the prior art itself, and not the applicant's achievement, that must establish the obviousness of the combination. Here, as will be illustrated, Applicants' invention is not rendered obvious by the prior art.

IV. CONCLUSION

In light of this response, Applicants respectfully contend that the present invention is not obvious. Further, Applicants respectfully request that the Examiner contact Applicants' undersigned attorney to further the prosecution of the case. Please charge any required fees and credit any credits to deposit account 02-2334.

Sincerely,



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